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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/589,214

11/28/2006

Thomas Walther

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7160

27799

7590

12/21/2010

COHEN, PONTANI, LIEBERMAN & PAVANE LLP

551 FIFTH AVENUE

SUITE 1210

NEW YORK, NY 10176

EXAMINER

CULLER, JILL E

ART UNIT

PAPER NUMBER

2854

MAIL DATE

DELIVERY MODE

12/21/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/589,214

Applicant(s)

WALTHER ET AL.

Examiner

Jill E. Culler

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 12, 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33,35-50,52-59 and 61-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33,35-50,52-59 and 61-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 33, 35, 36, 38, 40, 44-50, 52-59, 61-65, 80 and 81 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,656,081 to Isen et al.

With respect to claim 33, Isen et al. teaches a process for producing an RFID label having an antenna and an oscillating circuit by using a printing process, comprising: providing a printable substrate; applying at least part of at least one of the antenna and the oscillating circuit to the substrate using a conductive paste or conductive ink to print conducting tracks as the part of at least one of the antenna and the oscillating circuit, the step of applying using offset printing, and precoating, prevarnishing or preprinting the printable substrate with varnish or a pre-inking medium that reduces absorbent properties of the printable substrate to prevent or reduce absorption of the conductive paste or conductive ink by the substrate, thereby preventing or reducing a change in the inductance of the at least one of the antenna and the oscillating circuit. See column 3, line 64 - column 4, line 42, column 8, lines 1-12 and Fig. 5.

With respect to claim 35, Isen et al. teaches that the conductive ink is used and the conductive ink is an ink with metal particles. See column 6, lines 13-23.

With respect to claim 36, Isen et al. teaches that the conductive paste is used and the conductive paste contains carbon black or carbon fibers. See column 6, lines 13-23.

With respect to claim 40, Isen et al. teaches a further step of applying a protective varnish or protective ink to the substrate after part of at least one of the antenna and the oscillating circuit has been printed. See column 9, line 65 - column 10, line 4.

With respect to claims 44-47, Isen et al. teaches a process for producing an RFID label having an antenna and an oscillating circuit by using a printing process, comprising: providing a printable substrate; applying at least part of at least one of the antenna and the oscillating circuit to the substrate using a conductive paste or conductive ink to print conducting tracks as the part of at least one of the antenna and the oscillating circuit, the step of applying using a letterpress plate, with or without an offset cylinder, and precoating, prevarnishing or preprinting the printable substrate with varnish or a pre-inking medium that reduces absorbent properties of the printable substrate to prevent or reduce absorption of the conductive paste or conductive ink by the substrate, thereby preventing or reducing a change in the inductance of the at least one of the antenna and the oscillating circuit. See column 3, line 64 - column 4, line 42, column 8, lines 1-12 and Fig. 5.

With respect to claims 48-50, 57-59, 80 and 81, Isen et al. teaches the substrate can be a fibrous material, a film, or a fabric of at least one of natural and synthetic fibers and can be compressible. See column 10, lines 61-67.

With respect to claims 52-54 and 61-63, although Isen et al. does not explicitly teach the precoating, prevarnishing, or preprinting is effected by direct letterpress, by a letterpress plate, acting indirectly by way of a blanket cylinder, or by a printing unit in an offset press, it would have been obvious to one having ordinary skill in the art that all of these are conventional printing methods which could readily be applied to the application of this precoating as they were to the printing.

With respect to claims 55-56 and 64-65, Isen et al. teaches said step of applying further comprises the steps of printing two lines with different length next to each other over a certain portion of their length, and connecting the two lines to each other at ends of a shorter line of the two lines to produce a capacitive element, or of printing a base line, printing an insulator over part of the base line, and printing an opposing line to produce a capacitive element. See column 8, line 17 - column 9, line 17 and Fig 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33, 35, 36, 38, 40, 44-50, 52-59, 61-65, 80 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grabau et al. in view of U.S. Patent No. 6,712,931 to Gron et al.

With respect to claim 33 and 38, Grabau et al. teaches a process for producing an RFID label having an antenna and an oscillating circuit by using a printing process, comprising: providing a printable substrate; and applying at least part of at least one of the antenna and the oscillating circuit to the substrate using a conductive paste or conductive ink to print conducting tracks as the part of at least one of the antenna and the oscillating circuit. See column 4, lines 51 – column 5, line 8 and Figs. 1-2.

Grabau et al. does not teach precoating, prevarnishing or preprinting the substrate with varnish or a pre-inking medium that reduces absorbent properties of the printable substrate to prevent or reduce absorption of the conductive paste or conductive ink by the substrate, thereby preventing or reducing a change in the inductance of the at least one of the antenna and the oscillating circuit.

Gron et al. teaches a process for printing on a web including precoating, prevarnishing or preprinting the substrate with varnish or a pre-inking medium that reduces absorbent properties of the printable substrate to prevent or reduce absorption of the conductive paste or conductive ink by the substrate, thereby preventing or reducing a change in the inductance of the at least one of the antenna and the oscillating circuit. See column 3, lines 50-66.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the process of Grabau et al. to include a precoating step, as taught by Gron et al., in order to improve the precision of the printing on the web.

Although Grabau et al. does not teach this application using offset printing or a rotary web offset press, the teaching of Grabau et al. that the printing is carried out

using conventional printing cylinders (see column 4, lines 54-55) is considered to be sufficient to teach these limitations as the use of these cylinders with a web-fed press, as seen in Fig. 2 of Grabau et al. is well known in the art.

With respect to claim 35, Grabau et al. teaches that the conductive ink is used and the conductive ink is an ink with metal particles. See column 4, lines 55 – column 5, line 8.

With respect to claim 36, Grabau et al. teaches that the conductive paste is used and the conductive paste contains carbon black or carbon fibers. See column 4, lines 55 – column 5, line 8.

With respect to claim 40, Grabau et al. teaches a further step of applying a protective varnish or protective ink to the substrate after part of at least one of the antenna and the oscillating circuit has been printed. See column 6, lines 28-31.

With respect to claim 44, Grabau et al. teaches a process for producing an RFID label having an antenna and an oscillating circuit using a printing process, comprising: providing a printable substrate; and applying at least part of at least one of the antenna and the oscillating circuit directly or indirectly to the substrate using a conductive paste or conductive ink to print conducting tracks as the part of at least one of the antenna and the oscillating circuit. See column 4, lines 51 – column 5, line 8 and Figs. 1-2.

Grabau et al. does not teach precoating, prevarnishing or preprinting the printable substrate with varnish or a pre-inking medium that reduces absorbent properties of the substrate to prevent or reduce absorption of the conductive paste or

conductive ink by the substrate, thereby preventing or reducing a change in the inductance of the at least one of the antenna and the oscillating circuit.

Gron et al. teaches a process for printing on a web including precoating, prevarnishing or preprinting the printable substrate with varnish or a pre-inking medium that reduces absorbent properties of the printable substrate to prevent or reduce absorption of the conductive paste or conductive ink by the substrate, thereby preventing or reducing a change in the inductance of the at least one of the antenna and the oscillating circuit. See column 3, lines 50-66.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the process of Grabau et al. to include a precoating step, as taught by Gron et al., in order to improve the precision of the printing on the web.

With respect to claims 45-47, although Grabau does not explicitly teach the use of a letterpress plate with, or without an offset cylinder, the teaching of Grabau et al. that the printing is carried out using conventional printing cylinders (see column 4, lines 54-55) is considered to be sufficient to teach these limitations as the use of these cylinders with a web-fed press, as seen in Fig. 2 of Grabau et al. is well known in the art.

With respect to claims 48-50, 57-59, 80 and 81, Grabau et al. teaches the substrate can be a fibrous material, a film, or a fabric of at least one of natural and synthetic fibers and can be compressible. See column 4, lines 40-45.

With respect to claims 52-54 and 61-63, although Grabau et al. and Gron et al. do not explicitly teach the precoating, prevarnishing, or preprinting is effected by direct letterpress, by a letterpress plate, acting indirectly by way of a blanket cylinder, or by a

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printing unit in an offset press, it would have been obvious to one having ordinary skill in the art that all of these are conventional printing methods which could readily be applied to the application of this precoating as they were to the printing.

With respect to claims 55-56 and 64-65, Grabau et al. teaches said step of applying further comprises the steps of printing two lines with different length next to each other over a certain portion of their length, and connecting the two lines to each other at ends of a shorter line of the two lines to produce a capacitive element, or of printing a base line, printing an insulator over part of the base line, and printing an opposing line to produce a capacitive element. See column 5, lines 9-20 and Fig. 3.

Claims 37, 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grabau et al. in view of Gron et al., as applied to claims 33, 35, 36, 38, 40, 44-50, 52-59, 61-65, 80 and 81 above, and further in view of U.S. Patent No. 6,772,709 to Shibata.

With respect to claim 37, Grabau et al. and Gron et al. teach all that is claimed, as in the above rejection of claims 33, 35, 36, 38, 40, 44-50, 52-59, 61-65, 80 and 81, except that said step of applying comprises applying the conductive paste or the conductive ink in a sheet-fed offset press with gripper transport.

Shibata teaches that said step of applying comprises applying the conductive paste or the conductive ink in a sheet-fed offset press with gripper transport. See column 4, lines 1-29.

It would have been obvious to one having ordinary skill in the art at the time of the invention to further modify the process of Grabau et al. to operate with a sheet-fed offset press with gripper transport, as taught by Shibata, in order to be able to print on individual sheets instead of a continuous web which requires separation into individual components after the printing process.

With respect to claim 39, Shibata teaches that said step of applying includes applying part of at least one of the antenna and the oscillating circuit to a rear surface of the substrate which is formed as a sheet, and flipping over the sheet in a turning device. See column 4, lines 30-49.

With respect to claim 41, Grabau et al. and Gron et al. do not explicitly teach that said step of applying a protective varnish or protective ink comprises transferring the protective varnish or protective ink to the substrate in a sheet-fed offset press.

Shibata teaches applying a protective coating using a sheet-fed offset press. See column 4, lines 57-64.

It would have been obvious to one having ordinary skill in the art at the time of the invention to further modify the process of Grabau et al. to include applying the protective coating using a sheet-fed offset press, as taught by Shibata, in order to be able to apply the coating to individual sheets rather than a web.

Claims 37, 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isen et al. in view of U.S. Patent No. 6,772,709 to Shibata.

With respect to claim 37, Isen et al. teach all that is claimed, as in the above rejection of claims 33, 35, 36, 38, 40, 44-50, 52-59, 61-65, 80 and 81, except that said step of applying comprises applying the conductive paste or the conductive ink in a sheet-fed offset press with gripper transport.

Shibata teaches that said step of applying comprises applying the conductive paste or the conductive ink in a sheet-fed offset press with gripper transport. See column 4, lines 1-29.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the process of Isen et al. to operate with a sheet-fed offset press with gripper transport, as taught by Shibata, in order to be able to print on individual sheets instead of a continuous web which requires separation into individual components after the printing process.

With respect to claim 39, Shibata teaches that said step of applying includes applying part of at least one of the antenna and the oscillating circuit to a rear surface of the substrate which is formed as a sheet, and flipping over the sheet in a turning device. See column 4, lines 30-49.

With respect to claim 41, Isen et al. does not explicitly teach that said step of applying a protective varnish or protective ink comprises transferring the protective varnish or protective ink to the substrate in a sheet-fed offset press.

Shibata teaches applying a protective coating using a sheet-fed offset press. See column 4, lines 57-64.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the process of Isen et al. to include applying the protective coating using a sheet-fed offset press, as taught by Shibata, in order to be able to apply the coating to individual sheets rather than a web.

Claims 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grabau et al. in view of Gron et al., as applied to claims 33, 35, 36, 38, 40, 44-50, 52-59, 61-65, 80 and 81 above, and further in view of U.S. Patent No. 6,050,189 to Junghans et al.

With respect to claims 42-43, Grabau et al. and Gron et al. teach all that is claimed, as in the above rejection of claims 33, 35, 36, 38, 40, 44-50, 52-59, 61-65, 80 and 81, except wherein said step of applying a protective varnish or protective ink comprises transferring the protective varnish to the substrate in a flexo press with an ink chamber blade and a screen roller.

Junghans et al. teaches a method of applying a protective varnish or protective ink in a flexo press with an ink chamber blade and a screen roller. See column 6, lines 11-37 and Fig. 2.

It would have been obvious to one having ordinary skill in the art at the time of the invention to further modify the process of Grabau et al. to apply the varnish using a flexo press, as taught by Junghans et al., as Junghans et al. teaches this is an effective apparatus for applying a smooth surface.

Claims 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isen et al. in view of U.S. Patent No. 6,050,189 to Junghans et al.

With respect to claims 42-43, Isen et al. teaches all that is claimed, as in the above rejection of claims 33, 35, 36, 38, 40, 44-50, 52-59, 61-65, 80 and 81, except wherein said step of applying a protective varnish or protective ink comprises transferring the protective varnish to the substrate in a flexo press with an ink chamber blade and a screen roller.

Junghans et al. teaches a method of applying a protective varnish or protective ink in a flexo press with an ink chamber blade and a screen roller. See column 6, lines 11-37 and Fig. 2.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the process of Isen et al. to apply the varnish using a flexo press, as taught by Junghans et al., as Junghans et al. teaches this is an effective apparatus for applying a smooth surface.

Claims 66-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grabau et al. in view of Gron et al. as applied to claims 33, 35, 36, 38, 40, 44-50, 52-59, 61-65, 80 and 81 above, and further in view of U.S. Patent No. 6,246,327 to Eberhardt

With respect to claims 66 and 72, Grabau et al. and Gron et al. teach all that is claimed, as in the above rejection of claims 33, 35, 36, 38, 40, 44-50, 52-59, 61-65, 80 and 81 except for the steps of forming a recess in the substrate, and placing a further part of the oscillating circuit or an integrated circuit (IC) chip in the recess such that the

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further part of the oscillating circuit or the IC chip is mounted therein and connected to the part of the at least one of the antenna and the oscillating circuit, thereby producing a conductive connection between the further part of the oscillating circuit or the IC chip and the antenna.

Eberhardt teaches a process for creating an RFID circuit chip including the steps of forming a recess in the substrate, and placing a further part of the oscillating circuit or an integrated circuit (IC) chip in the recess such that the further part of the oscillating circuit or the IC chip is mounted therein and connected to the part of the at least one of the antenna and the oscillating circuit, thereby producing a conductive connection between the further part of the oscillating circuit or the IC chip and the antenna. See column 5, line 47 - column 6, line 17 and Fig. 8.

It would have been obvious to one having ordinary skill in the art at the time of the invention to further modify the process of Grabau et al. to include forming a recess for inserting the RFID chip, as taught by Eberhardt, in order to form a seamless surface as a better protection for the chip.

With respect to claims 67-68 and 73-74, Eberhardt teaches that the recess is formed sufficiently deep so that an upper surface of the further part of the oscillating circuit or the IC chip arranged parallel to an upper surface of the substrate is at least flush with the upper surface of the substrate or the antenna after it has been placed in the recess. See column 5, line 47 - column 6, line 17 and Fig. 8.

With respect to claims 69-70 and 75-76, Eberhardt teaches that said step of forming the recess includes stamping, impressing, or grooving the substrate in one or

more operating units within a printing press which is used for said step of applying. See column 5, line 47 - column 6, line 17 and Fig. 8.

With respect to claims 71 and 77, Eberhardt teaches that the substrate is a sheet and said step of forming the recess includes stamping, impressing, or grooving the substrate in a stamping press that produces one or more packaging cutouts from the substrate on which at least antennas and parts of oscillating circuits have been printed. See column 5, line 47 - column 6, line 17 and Fig. 8.

With respect to claims 78-79, Eberhardt teaches said step of applying includes applying at least one of an antenna or part of an oscillating circuit to the substrate, applying one of the oscillating circuit, a further part of the oscillating circuit, or an integrated circuit (IC) chip to the substrate together with the antenna or the part of the oscillating circuit, producing a conductive connection between the oscillating circuit or IC chip and the antenna, and sinking the oscillating circuit or IC chip and the antenna at least to a level of a surface of the substrate by deformation of the substrate. See column 5, line 47 - column 6, line 17 and Fig. 8.

Claims 66-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isen et al. in view of U.S. Patent No. 6,246,327 to Eberhardt

With respect to claims 66 and 72, Isen et al. teaches all that is claimed, as in the above rejection of claims 33, 35, 36, 38, 40, 44-50, 52-59, 61-65, 80 and 81 except for the steps of forming a recess in the substrate, and placing a further part of the oscillating circuit or an integrated circuit (IC) chip in the recess such that the further part

of the oscillating circuit or the IC chip is mounted therein and connected to the part of the at least one of the antenna and the oscillating circuit, thereby producing a conductive connection between the further part of the oscillating circuit or the IC chip and the antenna.

Eberhardt teaches a process for creating an RFID circuit chip including the steps of forming a recess in the substrate, and placing a further part of the oscillating circuit or an integrated circuit (IC) chip in the recess such that the further part of the oscillating circuit or the IC chip is mounted therein and connected to the part of the at least one of the antenna and the oscillating circuit, thereby producing a conductive connection between the further part of the oscillating circuit or the IC chip and the antenna. See column 5, line 47 - column 6, line 17 and Fig. 8.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the process of Isen et al. to include forming a recess for inserting the RFID chip, as taught by Eberhardt, in order to form a seamless surface as a better protection for the chip.

With respect to claims 67-68 and 73-74, Eberhardt teaches that the recess is formed sufficiently deep so that an upper surface of the further part of the oscillating circuit or the IC chip arranged parallel to an upper surface of the substrate is at least flush with the upper surface of the substrate or the antenna after it has been placed in the recess. See column 5, line 47 - column 6, line 17 and Fig. 8.

With respect to claims 69-70 and 75-76, Eberhardt teaches that said step of forming the recess includes stamping, impressing, or grooving the substrate in one or

more operating units within a printing press which is used for said step of applying. See column 5, line 47 - column 6, line 17 and Fig. 8.

With respect to claims 71 and 77, Eberhardt teaches that the substrate is a sheet and said step of forming the recess includes stamping, impressing, or grooving the substrate in a stamping press that produces one or more packaging cutouts from the substrate on which at least antennas and parts of oscillating circuits have been printed. See column 5, line 47 - column 6, line 17 and Fig. 8.

With respect to claims 78-79, Eberhardt teaches said step of applying includes applying at least one of an antenna or part of an oscillating circuit to the substrate, applying one of the oscillating circuit, a further part of the oscillating circuit, or an integrated circuit (IC) chip to the substrate together with the antenna or the part of the oscillating circuit, producing a conductive connection between the oscillating circuit or IC chip and the antenna, and sinking the oscillating circuit or IC chip and the antenna at least to a level of a surface of the substrate by deformation of the substrate. See column 5, line 47 - column 6, line 17 and Fig. 8.

Response to Arguments

Applicant's arguments filed October 12, 2010 have been fully considered but they are not persuasive.

In response to applicant's argument that Isen does not teach a printable substrate because the substrate disclosed by Isen is aluminum foil, which cannot absorb a paste or ink, Isen also discloses a variety of other possible substrates, many of

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which could absorb paste or ink. See column 10, line 61 - column 11, line 6. Therefore, as the purpose of the dielectric layer is to separate the substrate from said paste or ink, the layer would, in the case of these substrates, reduce absorbency of the paste or ink as well.

In response to applicant's argument that because Groen teaches a method for manufacturing a printable substrate it cannot teach the claimed step of pre-coating the printable substrate, this is not a persuasive argument. Groen teaches that adding a coating layer will reduce the absorbency of a printable substrate. This does not imply that the substrate would not be printable without said coating. Therefore, one having ordinary skill in the art at the time of the invention, wishing to reduce the absorbency of a printable substrate in an application such as that taught by Grabbau, would look to the teachings of Groen to find that this can be accomplished through a coating process and incorporate this coating step into a printing process in order to be able to use a substrate that was not previously coated with such a substance.

As further explanation, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Groen suggests that a coating layer is advantageous and one having ordinary skill in the art would be able to incorporate this suggestion into the printing method of Grabbau in order to realize this advantage.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill E. Culler whose telephone number is (571)272-2159. The examiner can normally be reached on M-F 10:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jec

/Jill E. Culler/
Primary Examiner, Art Unit 2854